

I. Amendments to the Specification

Please amend the specification by deleting the noted original paragraphs and replacing them with the following versions of the paragraphs.

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Page 1, lines 1-2:

~~This application contains subject matter protected by
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material which is subject to copyright protection. The copyright
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II. General Remarks Concerning This Response

Claims 1-6 and 8-20 are currently pending. In this response, no claims are amended; no claims are added; and no claims are canceled. Reconsideration of the claims is requested.

5 The Office action objected to the specification as having an improper copyright notice; the paragraph has been amended to present a proper copyright notice.

The Office action objected to the specification because "JAVA" was not properly noted as being a trademark, and the
10 Office action requested a substitute specification, which is being mailed separately from this response.

III. Statements in Office Action Regarding Previously Filed IDS

The Office action states the following about an IDS that was
15 filed by Applicant prior to filing the RCE in this application:

The Information Disclosure Statement filed July 9, 2003 (the "IDS") has been considered by the examiner.

However, the last reference listed on page 3 of the IDS and all of the references listed on page 4 of the IDS were
20 not considered by the examiner because they are non-patent literature and copies of these references do not appear to have been provided by applicants.

As an initial point, Applicant does not have any evidence
25 that the IDS was considered as stated in the Office action because the PTO did not provide a examiner-initialed copy of the IDS with the Office action. Applicant notes that Applicant did not misplace any such document because the Office Action Summary Form PTO-326 in the Office action does not acknowledge a copy of
30 the IDS as an attachment to the Office action, which supposedly would have occurred if such document were mailed with the Office action. Applicant kindly requests an examiner-initialed copy of the IDS.

Appl. Serial No.: 09/409,370
Filing Date: 09/30/1999
Inventor: Claussen et al.
Title: Method for processing a document object
model (DOM) tree using a tagbean
Atty. Docket No.: AT9-99-485

Date Mailed: 7/7/2003

Filed in the
United States Patent Office
on:

Papers Filed Herewith:

- Transmittal Document
- Information Disclosure Statement (IDS)
- Form PTO-1449
- Copy of References [35]



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In addition, Applicant did provide the PTO with copies of all references that were cited in the IDS, as evidenced by the copy of the returned postcard on page 4 of this response. The copy of the postcard shows that the original postcard was
5 received and acknowledged by the PTO, which provides evidence of all documents that were filed with the original postcard; the original postcard shows that 35 reference documents were filed with the IDS. Hence, the PTO has apparently lost the references.

Applicant is submitting another copy of the IDS with
10 additional copies of the non-patent literature; the IDS is being mailed separately from this response. Applicant kindly requests consideration of the IDS.

Moreover, Applicant notes that the administrative or procedural error lies with the PTO. **If the PTO subsequently
15 issues a rejection based on any of the references that are listed in the IDS, Applicant notes that the rejection must be NON-FINAL because the prior art was submitted not only prior to the current Office action but also prior to the filing of the RCE in the present application; thus, Applicant would not be raising any new
20 issues with the submission of the re-filed IDS.**

IV. Rejections over *JavaServer Pages*TM Specification Vers. 1.1

The Office action has rejected all of the claims in some manner in view of Pelegri-Llopart et al., *JavaServer Pages*TM
25 *Specification Vers. 1.1*, Sun Microsystems, Inc., 08/18/1999 (JSP 1.1). The rejection is traversed.

Applicant respectfully asserts that Applicant completed and reduced to practice the claimed invention before the publication of JSP 1.1 (August 18, 1999). More than one declaration,
30 pursuant to 37 C.F.R. § 1.131, has been duly executed by Shane

Claussen, an inventor of the present invention; one declaration was included with Applicant's previous response, and reconsideration of the previous declaration is kindly requested in conjunction with consideration of another declaration that has been filed with this response. The inventor declares that Applicant's claimed invention was completed and reduced to practice prior to August 18, 1999. Exhibit "A" to the inventor's declarations are multiple IBM Invention Disclosure Forms ("the disclosure form") that disclosed Applicant's claimed invention. Each disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to August 18, 1999. The inventor's declarations under 37 C.F.R. § 1.131, therefore, remove JSP 1.1 from consideration as prior art. Because JSP 1.1 should not be considered with respect to Applicant's claimed invention, the rejection fails to make a *prima facie* case of obviousness in rejecting the pending claims. Applicant respectfully asserts that the claims are allowable.

V. Arguments in support of Applicant's 1.131 Declaration

The Office action raises multiple issues with respect to Applicant's previously submitted declaration under 37 C.F.R. § 1.131, which the Office action describes as "ineffective".

The Office action states the following on pages 2 and 3:

The declaration filed on 05/28/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Eduardo Peligri-Lopart et al., *Java Server Pages™ Specification* (Version 1.1 Public Release, August 18, 1999) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Eduardo Peligri-Lopart et al., *Java Server Pages™ Specification* (Version 1.1 Public Release, August 18, 1999) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to

another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

5 Applicant's affidavit must disclose the claimed invention and the applicant should explain how the IBM disclosure corresponds to the specific claims. For example, the applicant's claim cites limitations such as "the tag handler is registered in a tag library, wherein the tag
10 library contains one or more elements defining tags, wherein an element defining the tag contains an attribute for the tag handler that processes an instance of the tag", which are not disclosed in the "Idea of a Disclosure" statement. The Invention Disclosure form AUS8-1999-0727 deals with
15 special style java tagbean and vaguely mentions that tagbean writers find it cumbersome to perform simple token replacement; however, there is no evidence that the applicant actually conceived and reduced to practice the invention. Applicant is requested to map out exactly how
20 the claim limitations are comprehended in the IBM disclosure.

As an initial point, Applicant notes that the previously filed inventor's declaration under 37 C.F.R. § 1.131 contained
25 two disclosure forms that were submitted collectively as "the disclosure form". The Office action only refers to "Invention Disclosure form AUS8-1999-0727" (so-called by the Office action), but Applicant submitted an additional document "Disclosure AUS8-1999-0728" in the inventor's declaration together with
30 "Disclosure AUS8-1999-0727". These two disclosure documents together provide the basis for distinguishing the present invention that is claimed in this patent application versus any other invention that is claimed in any other patent application that has been filed by Applicant. Applicant requests that all
35 disclosure documents be considered collectively as "the disclosure document" with respect to the patentability arguments that are provided herein for the present patent application.